

PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q76385

Seimei USHIRO, et al.

Appln. No.: 10/631,894

Group Art Unit: 1745

Confirmation No.: 9808

Examiner: Keith D. WALKER

Filed: August 1, 2003

For: FUEL CELL SYSTEM, FUEL PACK, CAMERA, PORTABLE TELEPHONE WITH
CAMERA AND PORTABLE TERMINAL

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits
this Reply Brief in response to the Examiner's Answer dated August 24, 2006. Entry of this
Reply Brief is respectfully requested.

Table of Contents

STATUS OF CLAIMS	2
GROUND OF REJECTION TO BE REVIEWED ON APPEAL	3
ARGUMENT.....	4
CONCLUSION	6

REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appln. No.: 10/631,894

STATUS OF CLAIMS

Claims 25-28 and 51-59 are pending in the application. Claims 25-28 and 51-59 are rejected (*see* final Office Action dated December 9, 2005). Claims 25-28 and 51-59 are the claims on appeal (*see* Appendix).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

- Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Prasad (U.S. Publication No. 2003/0082427), Ohtani (U.S. Patent 6,118,949) and Peterson et al. (U.S. Patent 3,439,596) in view of Shioya (U.S. Patent 6,916,565).
- Claims 26 and 27 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Prasad in view of Shioya and further in view of Lonka (U.S. Patent 6,308,084).
- Claim 28 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Prasad in view of Shioya.
- Claims 51, 52 and 55-57 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Prasad in view of Shioya.
- Claims 53 and 54 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Prasad in view of Shioya and further in view of Bateman (U.S. Patent 5,909,818).
- Claim 58 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Prasad in view of Shioya and further in view of Faris (U.S. Patent 6,558,825).
- Claim 59 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Prasad in view of Shioya and Faris.

ARGUMENT

With respect to the rejections of independent claims 25, 26, 28, and 51, in the Response to Argument section of the Examiner's Answer,¹ the Examiner asserts that the motivation for modifying the fuel cell system of Prasad to use a secondary cell, such as that disclosed in Shioya, that is "adjacent to the fuel cell" is to provide an efficient power transfer.

However, Applicant respectfully submits that there is no objective evidence of record to support the Examiner's assertion.² This evidence must come from one of three sources: 1) from the prior art references themselves, 2) from the knowledge of one of ordinary skill, or (3) from the nature of the problem to be solved.³

Although the asserted motivation is discussed in the Appeal Brief at page 4, lines 4-10,⁴ the arguments in the Appeal Brief are not evidence of the reasoning of a hypothetical person of

¹ See Answer at page 11.

² The USPTO is held to a *rigorous* standard when trying to show that an invention would have been obvious in view of the combination of two or more references. See, *In re Sang Su Lee*, 227 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002), *citing, e.g., In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."). In *Lee*, the Federal Circuit further emphasized that the "need for specificity pervades this authority." (*Lee* at 1433 (*citing In re Kotzab*, 217 F.3d 1365, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"))). The factual inquiry into whether to combine references "must be based on objective evidence of record." *Lee* at 1433.

³ See *Ruiz v. A.B. Chance*, 234 F.3d 654, 666, 57 USPQ2d 1161 (Fed Cir. 2000).

⁴ See Answer at A & B, pages 11-14.

ordinary skill in the art *when the invention was unknown and just before it was made.*⁵

Specifically, the Examiner has not identified evidence anywhere in the file record of the present application of a motivation for the one of ordinary skill at the time of invention to modify the fuel cell system of Prasad in the asserted manner.

Moreover, with respect to the rejection of independent claim 26, the Examiner asserts that the motivation for placing the fuel cell in the keyboard portion of a portable telephone is to create a lower center of gravity for a camera phone.⁶

Again, Applicant respectfully submits that there is no objective evidence of record to support the Examiner's assertion.

⁵ See, for example, *In re Kotzab*, 217 F.3d 1365, 1369, 55 USPQ2d 1313 (Fed. Cir. 2000) ("A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field.") See also *MPEP* 2142 (page 2100-133). "To reach a proper determination under 35 U.S.C. 103, the examiner must step back into the shoes worn by the hypothetical person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person.... impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art."

⁶ See Answer at C, page 15.

REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appln. No.: 10/631,894

CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal. An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,


SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

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CUSTOMER NUMBER

Date: October 24, 2006



John M. Bird
Registration No. 46,027

Attorney Docket No.: Q76385